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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,298	08/08/2001	Vincent Bryan	46739/262600	3319

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EXAMINER

PRIDDY, MICHAEL B

ART UNIT PAPER NUMBER

3732

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/924,298

Applicant(s)

BRYAN ET AL.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44, 56-61, 64-67, 69-71, 74-76, 81-96, 101, 102, 106-110 and 112-120 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-44, 56-61, 64-67, 70, 71, 74-76, 81-96, 101, 102, 106-110 and 112-120 is/are allowed.
- 6) ☒ Claim(s) 69 and 103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Büttner-Janz et al. (4,759,766) in view of Conta (WO 93/16656). Büttner-Janz et al. teach a bone joint implant comprising a central body 3 positioned between two shells 1 & 2 each having an inner surface that contacts the central body. Hence Büttner-Janz et al. teach all of the limitations of the present invention except that the outer surface of at least one shell is coated to promote bony ingrowth, and wherein the coating is a nonspherical sintered bead coating.

Conta teaches sintered coatings for implantable prostheses such as acetabular cups wherein said coatings include both generally smaller spherically-shaped particles and generally larger non-spherically-shaped particles, with the non-spherically-shaped particles providing enhanced surface roughness and the spherically-shaped particles providing support for the non-spherically shaped particles. It would have been obvious to one of ordinary skill in the art at the time of the present invention to coat the outer surface of the shells of Büttner-Janz et al. with non-spherically-shaped particles to improve the surface roughness of the implantable prosthesis thereby increasing the surface friction and the likelihood of bone ingrowth.

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Claim 103 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryan et al. in view of Buechel et al. (US 5,868,796). Bryan et al. teach a surgical implant 18 comprising a central body 20 having a resilient, deformable portion. Hence, Bryan et al. teaches all of the limitations of the present invention except a coating on the central body, wherein the coating increases the surface lubricity of the central body.

Buechel et al. teach a biologically inert wear resistant surface 26 on the head 18 of a femoral, stem-type prosthesis. The surface is the result of a titanium nitride coating. "The much smoother characteristics of surfaces subjected to wear that are enabled by the harder coating 26 contribute substantially to wear resistance, abrasion resistance and lubricity. It would have been obvious to one of ordinary skill in the art at the time of the present invention to apply titanium nitride to the bearing surface of the central body 20 of Bryan et al. so as to substantially improve its wear resistance.

#### ***Allowable Subject Matter***

Claims 1-44, 56-61, 64-67, 70, 71, 74-76, 81-96, 101, 102, 106-110 and 112-120 are allowed.

Claim 69, previously indicated as allowable, has been rejected herein as a result of further search and consideration. The Examiner sincerely regrets any inconvenience to Applicant or Applicant's representative.

### ***Response to Arguments***

In response to Applicant's arguments with respect to claim 103, the Examiner asserts Bryan et al. does indeed teach a central body having a resilient, deformable portion (see lines 49-52 of column 2).

Concerning Applicant's allegation that Buechel et al. teaches away from claimed invention, the Examiner points out that Buechel et al. has been used to modify Bryan et al. not the other way around. Therefore, the fact that Buechel et al. teaches a metallic substrate as opposed to a central body having a resilient, deformable portion, is irrelevant.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

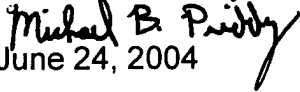
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael B. Priddy

  
June 24, 2004